

REMARKS

Claims 1-10 are pending in the present application. Applicants respectfully request entry of the above amendment to claim 1. Applicants submit that no new matter is added. Accordingly, claims 1-10 remain pending in the application.

In section 2 of the Office Action, the Examiner rejected claims 1, 3, 4, 6, 7 and 10 under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent No. 6,244,763 to Miller ("Miller '763") in view of U.S. Patent No. 5,829,985 to Hayashi, et al. ("Hayashi '985").

Applicants respectfully traverse the rejection. Applicants respectfully submit that claim 1 has been amended for clarity only without changing the scope of the claim. Claim 1 as originally filed recited a "label pair" and the amended claim 1 clarifies the two labels in the pair.

Applicants respectfully submit that the cited references are not properly combined and do not constitute a *prima facie* case of obviousness.

First, one of skill in the art would not look to Hayashi '985 to modify Miller '763. For example, Hayashi '985 teaches methods of printing a single indicia on a mail piece and is not related to printing label pairs.

Secondly, even if the references were properly combined, Hayashi '985 teaches a security method of ensuring that the same indicia comprising two print passes is not split to print two indicia each comprising a single pass. The "VOID" security features taught in Hayashi '985 do not uniquely identify the label or the indicia used, but provides an indication that both passes were not used to form the indicia. As can be appreciated, there is no teaching or suggestion of printing label pairs or of providing an identification mark on each label of the pair to correlate the labels of the pair.

The invention as presently claimed in claim 1 recites tagging the label pair with a unique identifying mark. As can be appreciated, the security feature taught in

Hayashi '985 as shown in FIGs. 6c-6e do not match the two printing passes, but rather indicate whether both were completed in the same area on a single substrate.

Applicants respectfully submit that the invention as presently claimed in dependent claims 3, 4, 6 and 7 are patentable over the cited references for at least the reasons stated above with reference to claim 1.

Additionally, referring to claim 3, Applicants further submit that the cited references do not teach or suggest alone or in proper combination printing a destination address first and subsequently printing a corresponding indicia.

Similarly, Applicants respectfully submit that independent claim 10 also recites tagging a label pair with a unique identifying mark and is patentable over the cited references for at least the reasons stated above with reference to claim 1.

Therefore, for at least the reasons stated above, Applicants respectfully submit that the invention as presently claimed in claims 1, 3, 4, 6, 7 and 10 is patentable over the cited references. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

In section 3 of the Office Action, the Examiner rejected claims 2 and 8 under 35 U.S.C. 103(a) as allegedly rendered obvious by Miller '763 in view of Hayashi '895 and further in view of U.S. Patent No. 5,925,864 to Sansone ("Sansone '864").

Applicants respectfully traverse the rejection for at least the reasons stated above with regard to Miller '763 and Hayashi '895 in responding to section 2 of the Office Action. Additionally, one of skill in the art would not look to Sansone '864 to modify Miller '763 as Sansone '864 does not correlate two labels using two copies of an identifier, but identifies a mail piece using a single identifier.

Accordingly, Applicants submit that for at least the reasons stated above, the cited references do not alone or in proper combination render obvious the invention as presently claimed in dependent claims 2 and 8. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

In section 4 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. 103(a) as allegedly rendered obvious by Miller '763 in view of Hayashi '895 and further in view of U.S. Patent No. 6,188,996 to Sansone ("Sansone '996").

Applicants respectfully traverse the rejection for at least the reasons stated above with regard to Miller '763 and Hayashi '895 in responding to section 2 of the Office Action.

Additionally, Applicants submit that under 35 U.S.C. 103 (c), Sansone '996 is not available as prior art under 35 U.S.C. 103 (a). Filed concurrently herewith is a Statement of Common Ownership, dated January 4, 2002 by Robert E. Meyer, agent of record, stating that Sansone '996 and the present application were commonly owned or subject to an obligation of assignment at the time of invention for the present application. Accordingly, Applicants submit that the cited references are not properly combined and respectfully request that the Examiner withdraw the rejection.

Applicants submit that for at least the reasons stated above, the cited references do not alone or in proper combination render obvious the invention as presently claimed in dependent claim 5. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

In section 5 of the Office Action, the Examiner rejected claim 9 under 35 U.S.C. 103(a) as allegedly rendered obvious by Miller '763 in view of Hayashi '895 and further in view of U.S. Patent No. 6,010,156 to Block ("Block '156").

Applicants respectfully traverse the rejection for at least the reasons stated above with regard to Miller '763 and Hayashi '895 in responding to section 2 of the Office Action. Additionally, Applicants respectfully submit that the Block '156 reference does not teach or suggest a hash line identifier because the facing mark described is a constant mark and is not used to identify a label.

Accordingly, Applicants submit that for at least the reasons stated above, the cited references do not alone or in proper combination render obvious the invention

as presently claimed in dependent claim 9. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection.

COMMONLY OWNED APPLICATION

Applicants respectfully draw the Examiner's attention to commonly owned, commonly assigned U.S. Patent Application Serial No. 09/433,482 ("482 application"). Applicants submit that the '482 application is not prior art against the present application and will shortly submit an appropriate Information Disclosure Statement.

CONCLUSION OF REMARKS

For at least the reasons stated above, it is respectfully submitted that the claims of this application are in condition for allowance and early and favorable action thereon is requested.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicants at (203) 924-3180.

AUTHORIZATION

No fee, other than the fee for the enclosed petition for extension of time, is believed due with this response. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-147.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time

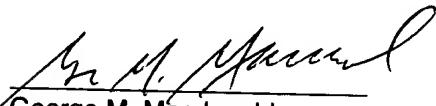
Serial No.: 09/690,284
Attorney Docket No.: F-147

Patent

or credit any overpayment for an extension of time to the Pitney Bowes, Inc. Deposit Account Number 16-1885, Order No. F-147.

Dated: January 4, 2002

Respectfully submitted,


George M. Macdonald
Reg. No. 39,284
Attorney for Applicants
Telephone (203) 924-3180

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000

APPENDIX A - Version with Markings to Show Changes Made

In the claims:

1. (Amended) A method for printing an indicia on a label in a system for printing one or more labels comprising the steps of:
 - (a) reading a label configuration file wherein said label configuration file is indicative of one or more label stocks;
 - (b) selecting a label stock;
 - (c) reading a definition file associated with said selected label stock;
 - (d) selecting an amount of labels to be printed;
 - (e) printing said amount of labels in accordance with said definition file such that a label pair comprising a destination address label having a destination address and a corresponding indicia label having an indicia is printed, wherein said corresponding indicia further comprises a destination barcode; and
 - (f) tagging said label pair with a unique identifying mark.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Robert J. Johnson, et al.

Attorney Docket No.: F-147

) Group Art Unit: 2876

Serial No.: 09/690,284

) Examiner: Seung H. Lee

Filed: October 17, 2000

) Date: January 4, 2002

Title: **METHOD FOR PRINTING A LABEL PAIR WITH INFORMATION-BASED INDICIA PROGRAM (IBIP) INDICIA**

STATEMENT OF COMMON OWNERSHIP UNDER 35 U.S.C. § 103(C)

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The above referenced U.S. Patent Application Serial No. 09/690,284 ("the present application") was filed on or after November 29, 1999.

The present application and United States Patent 6,188,996 issued to Sansone ("996 patent") were, at the time of the invention of the present application, commonly owned by or subject to an obligation of assignment to the same entity, namely Pitney Bowes Inc.

Respectfully submitted,

Robert E. Meyer
Reg. No. 26,307
Agent of Record
Telephone (203) 924-3848

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000